

GAU 1653

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT OPERATIONS

In re Application of:)
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)
Raffaello Giorgi et al.) Group Art Unit: 1653
)
Serial No.: 09/355,210) Examiner: Lukton, D.
)
Filed: July 12, 2000)

For: MONOCYCLIC COMPOUNDS WITH FOUR BIFUNCTIONAL RESIDUES
HAVING NK-2 ANTAGONIST ACTION

New York, NY 10036
April 11, 2001

Commissioner for Patents
Washington, DC 20231

RESPONSE TO OFFICE ACTION

Sir:

In response to the restriction requirement, the applicant elects, with traverse, Group I, with the compound of Example 38 as the elected specie.

The present application is a national stage application of a Patent Cooperation Treaty (PCT) application. Under Article 27 of the PCT, national law cannot require different requirements as to form than are provided for in the PCT. Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks, 231 USPQ 590 (EDVA 1986), copy attached. In the present case the compounds, method for their preparation and the method of using the compounds are properly placed in one application.

The Examiner's authority to require the election of species is set forth in MPEPS 808.01(a). The provisions of Chapter 800 are limited to applications filed under 35 U.S.C. §111 and may not be applied to §371 applications:

" 801 Introduction

This chapter is limited to a discussion of the subject of restriction and double patenting under U.S.C. Title 35 and the Rules of Practice as it relates to national applications filed under 35 U.S.C.111. The discussion of unity of invention under the Patent Cooperation Treaty Articles and Rules as it is applied as an International Searching Authority, International Preliminary Examining Authority, and in applications entering the National Stage under 35 U.S.C. 371 as a Designated or Elected Office in the Patent and Trademark Office is covered in Chapter 1800." (emphasis added)

There is no mention of species election in Chapter 1800 of the MPEP and for this reason, it is requested that the present requirement be withdrawn.

The Examiner has pointed to the term "special technical features" as meaning the technical features that define a contribution over the prior art. The Examiner also noted that the determination of the "special technical features" is made based on the contents of the claims as interpreted in light of the description of the present invention . This determination is not made based on the prior art.

At page AI33, of the attached copy of Annex B of the Administrative Instructions of the PCT (July 1998), Example 1 describes a situation where claims to a compound, method of making the compound and method using the compound are considered to meet the unity of invention requirement under Rule 13.2 of the PCT. Example 1 of the Administrative Instructions Under the PCT is completely analogous to the present application and for this reason, it is requested that the present requirement be withdrawn and a action be provided on all claims.

An early and favorable action is earnestly solicited.

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Respectfully submitted,


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